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Paper No.

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**MAY 24 2004**

**OFFICE OF PETITIONS**

In re Application of	:	OFFICE OF PETITIONS
Zhu et al.	:	
Application No. 09/782,185	:	DECISION ON
Filed: February 12, 2001	:	PETITION
Attorney Docket No. LAM1P147/P0675	:	

This is a decision on the "PETITION TO REVIVE UNAVOIDABLY ABANDONED APPLICATION OR LAPSED PATENT (37 CFR 1.137(a)), filed March 30, 2004.

The petition under § 1.137(a) is **DISMISSED**.

The petition under § 1.137(b) is **GRANTED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision<sup>1</sup>. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time are permitted under § 1.136(a).

The above-identified application became abandoned for failure to timely pay the required issue fee within the statutory period of three (3) months from the mailing date, November 7, 2003, of the Notice of Allowance and Fee(s) Due. No extensions of time are permitted for transmitting issue fees. Applicants also did not pay the required publication fee. Accordingly, the above-identified application became abandoned on February 8, 2004. A Notice of Abandonment was mailed on March 24, 2004.

The instant petition was promptly filed. Therein, petitioner maintains that the entire delay in filing the required reply from the due date of the reply until the filing of this petition was unavoidable as the Notice of Allowance and Fee Due was never received in the Office of the attorney for applicants. In

<sup>1</sup> Further correspondence with respect to this matter should be addressed as follows: By mail: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450; or, By FAX: (703) 872-9306, ATTN: NANCY JOHNSON, SENIOR PETITIONS ATTORNEY; or, By hand: CUSTOMER SERVICE WINDOW, 2011 South Clark Place, Crystal Plaza Two Lobby, Arlington, VA 22202.

support thereof, petitioner submitted papers identified as mail logs for the period from November 6, 2003 through December 5, 2003.

Petitioner requests that in the event that the petition under § 1.137(a) is dismissed, the petition be treated as a "Petition to Revive for Patent Application Abandoned Unintentionally."

**Consideration under § 1.137(a)**

A grantable petition under § 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to § 1.137(d). The instant petition lacks item(3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

A review of the application file reveals no irregularities in the mailing of the Notice of Allowance and Fee(s) Due. Thus, there is a strong presumption that the correspondence was properly mailed to the applicant at the correspondence address of record. In the absence of demonstrated irregularities in mailing of this Notice, petitioner must submit evidence to overcome this presumption. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not

received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. In addition, a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the non-received Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office action must be submitted as documentary proof of non-receipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

Petitioner's claim of non-receipt of the Notice of Allowance is not adequately supported. In his declaration, practitioner does not attest to a search of the file jacket and docket records indicating that the Office communication was not received. Rather, he declares that he reviewed a mail log. Further, the "mail log" reviewed by practitioner and submitted on petition does not show all replies docketed for a date three months from the mail date of the Notice of Allowance (which set a three month period for reply).

Having not made an adequate showing of non-receipt of the Office action, the petition cannot be granted under §1.137(a).

The petition is **DISMISSED** without prejudice to reconsideration upon the timely submission of a copy of the docket record and a statement from the responsible attorney or patent agent that his or her search of the file jacket and docket records indicates that the Office communication was not received.

#### **Consideration under § 1.137(b)**

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, the showing is sufficient to revive the application under §1.137(b) on the basis of unintentional delay<sup>2</sup>. Petitioner has submitted the required reply, payment of the issue fee and the publication fee. (The Notice of Allowability did not set forth a distinct and concurrent requirement for new drawings). The petition fee has been charged to Deposit Account No. 50-0388, as authorized. 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." The statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3). The statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3).

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<sup>2</sup> A grantable petition under §1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to §1.137(d)

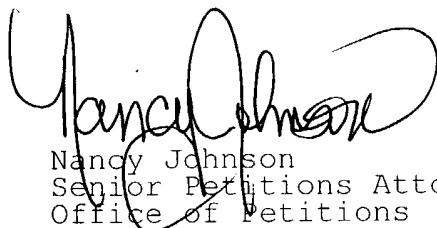
Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition. As this utility application was filed after June 8, 1995, no terminal disclaimer is required.

Accordingly, the petition is granted under § 1.137(b).

The Publishing Division has been advised of this decision reviving the application and that this application is ready for processing into a patent.

Receipt is acknowledged of an Information Disclosure Statement (IDS) filed March 30, 2004. It is petitioner's responsibility to determine if any further action is required to obtain consideration by the examiner of the IDS filed the same date as payment of the Issue Fee (i.e. Petition to Withdraw from Issue).

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-0309.



Nancy Johnson  
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Office of Petitions